

jc893 U.S. PTO
10/25/01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. EIGEN ET AL (DIV)
Anticipated Classification of this
application: _____
Prior application: _____
Examiner: E. CAMPBELL
Art Unit: 1656

**Assistant Commissioner for Patents
Washington, D.C. 20231**

REQUEST FOR FILING A DIVISIONAL APPLICATION

This is a request for filing a

Continuation
Divisional

application under 37 CFR 1.53, of pending prior application serial no. 08/362,604 filed
on March 22, 1996 of Manfred EIGEN ET AL for
(date) (inventor(s))

Process and Agent for Instabilizing Viral Quasi-Species-Distributions Avoiding Resistance Phenomena
(title of invention)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this 37 CFR 1.53 Request and the documents referred to as attached therein are being deposited with the United States Postal Service on this date October 25, 2001 in an envelope as "Express Mail Post Office to Addressee" service under 37 CFR 1.10, Mailing Label No. EL 871449077 US addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Lisa L. Vulpis
(Type or print name of person mailing paper)

Lisa L. Vulpis
(Signature of person mailing paper)

NOTE: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing (37 CFR 1.10(b)).

1. **Copy of Prior Application as Filed Which is Attached**

The copy of the papers of prior application *as filed* which are attached are as follows:

27 page(s) of specification

6 page(s) of claims

1 page(s) of abstract

8 sheets(s) of drawings

(Also complete part 6 below if drawings are to be transferred)

20 pages of declaration and power of attorney

2. **Amendments**

WARNING: *"The claim of a new application may finally rejected in the first Office Action in those situations where (a) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application." MPEP § 706.07(b).*

X Cancel in this application original claims 1-23 of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

X A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered **original** claim in the prior application.)

NOTE: Only amendment reducing the number of claims or adding a reference to the prior application (Rule 1.78(a)) will be entered before calculating the filing fee and granting the filing date. 37 CFR 1.60(b).

3. **Petition for Suspension of Prosecution for the Time Necessary to File an Amendment**

Note: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered), it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

 There is provided herewith a Petition to Suspend Prosecution For The Time Necessary to File an Amendment (New Application Filed Concurrently).

4. Fee Calculation

CLAIMS AS FILED

| Number filed | Number Extra | Rate | Basic Fee |
|---|--------------|------|-----------|
| | | | \$740.00 |
| Total claims | 23 - 20= | 3 x | \$ 18.00 |
| Independent | | | \$ 54.00 |
| Claims (37 CFR 1.16(b)) | 3 - 3= | 0 x | \$ 84.00 |
| | | | \$ |
| Multiple dependent claim(s), if any (37 CFR 1.16(d)) | | x | \$280.00 |
| | | | \$ |

___ Fee for extra claims is not being paid at this time (37 CFR 1.16(d))

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency. 37 CFR 1.16(d).

Filing Fee Calculation \$ 794.00

5. Small Entity Status

___ A verified statement that this filing is by a small entity:

___ is attached

___ has been filed in the parent application and such status is still proper and desired (37 CFR 1.28(a)).

Filing Fee Calculation (50% of above) \$ _____

NOTE: Any excess of the full fee paid will be refunded if a verified statement is filed within 2 months of the date of timely payment of a full fee; then the excess fee paid will be refunded upon request.

37 CFR 1.28(a).

NOTE: 37 CFR 1.28(a), last sentence, states: "Applications filed under § 1.60 or § 1.62 of this part must include a -+reference to a verified statement in a parent application if status as a small entity is still proper and desired."

6. Drawings

WARNING: Do not check the following box if prior case is not to be abandoned.

___ Transfer the drawings from the prior application to this application and, subject to item 17 below, abandon said prior application as of the filing date accorded this application. A duplicate copy of this request is enclosed for filing in the prior application file. (May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record authorized by 37 CFR 1.138 and before payment of issue fee.)

NOTE: "A registered attorney or agent acting under the provisions of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138.

___ Transfer the following sheet(s) of drawings from the prior application to this application _____

NOTE: Transferred sheets must be canceled in the prior application. 37 CFR 1.88.

___ A **copy** of the amendment canceling these sheets of drawings in the prior application is attached.

X New drawings are enclosed

X formal

___ informal

WARNING: DO NOT submit original drawings. A high quality copy of drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards of § 1.84. If corrections to the drawings are necessary, they should be made to the original drawings and a high-quality copy of the corrected original drawing then submitted to the Office Only one copy is required or desired. Comments on proposed new 37 CFR 1.84. Notice of March 9, 1988 (1090 O.G. 57-62).

NOTE: "Identifying indicia such as the serial number, group art unit, title of the inventor, attorney's docket number, inventor's name, number of sheets, etc. not to exceed 2¾ inches (7.0 cm) in width may be placed in a centered location between the side edges within three-fourths inch (19.1 mm) of the top edge. Either this marking technique on the front of the drawing or the placement, although not preferred, of this information and the title of the invention on the back of the drawings is acceptable." Proposed 37 CFR 1.84(1). Notice of March 9, 1988 (1090 O.G. 57-62).

7. Priority - 35 U.S.C. 119

X Priority of application serial no. P 42 22 289,3
filed on July 7, 1992 in Germany
is claimed under 35 U.S.C. 119. (country)

X The certified copy has been filed in prior U.S. application
serial no. 08/362,604 on March 22, 1996

___ The certified copy will follow.

8. **Relate Back - 35 U.S.C. 120**

 X Amend the specification by inserting before the first line in the sentence:
"This is a
____ continuation
 X divisional
of copending application(s)
 X Serial number 08/362,604
filed on March 22, 1996
 X International Application PCT/EP 93/01711 filed on July 2, 1993
and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application which entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application which designated the U.S.

9. **Inventorship Statement**

NOTE: If the continuation or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. 37 CFR 1.60(b) [emphasis added].
(complete appropriate items (a) and (b))

(a) With respect to the prior copending U.S. application from which this application claims benefit under 35 U.S.C. 120, the inventor(s) in this application is (are):

(complete applicable item below)

 X the same
____ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

(Type name(s) of inventor(s) to be deleted)

(b) The inventorship for all the claims in this application are

 X the same
____ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

10. Assignment

X The prior application is assigned of record to
EVOTECH BIOSYSTEMS AG

X Assignment recorded in PTO on January 26, 1999
Reel 9721 Frame 0085

 an assignment of the invention to _____

is attached

11. Fee Payment Being Made At This Time

 Not Enclosed

 No filing fee is submitted. (This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently).

X Enclosed

| | |
|---|------------------|
| <u>X</u> basic filing fee | \$ <u>794.00</u> |
| <u> </u> recording assignment (\$40.00; 37 CFR 1.21(h)) | \$ _____ |
| <u> </u> processing and retention fee (\$120.00; 37 CFR 1.53(d) and 121(l)) | \$ _____ |

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as the changes to 37 CFR 1.53 and 1.78, indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid or else the processing and retention fee of § 1.21(l) must be paid within 1 year from notification under § 53(d).

12. Method of Payment of Fees

X enclosed is a check in the amount of \$ 794.00

 charge Account No. _____ in the amount of \$ _____.

A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that is clear for which purpose the fees are paid. 37 CFR 1.22(b).

13. Authorization to Charge Additional Fees

WARNING: If no fees are being paid on filing do not complete this item.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges if extra claim charges are authorized.

 X The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the entire pendency of the application to Account No. 03-2468 .

 X 37 CFR 1.16(a), (f) or (g) (filing fees)

 X 37 CFR 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

 X 37 CFR 1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under § 1.136(a), this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a request or petition for extension is filed." [emphasis added]. notice of November 5, 1985 (1060 O.G. 27).

 37 CFR 1.18 (issue fee at or before mailing Notice of Allowance, pursuant to 37 CFR 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the Notice of Allowance. 37 CFR 1.1311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application ... prior to paying or at the time of paying ... issue fee." Form the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

100333697 103504

14. **Power of Attorney**

X The power of attorney in the prior application is to

| | |
|---------------------------|---------------|
| <u>Allison C. Collard</u> | <u>22,532</u> |
| Attorney | Reg. No. |
| <u>Edward R. Freedman</u> | <u>26,048</u> |
| Attorney | Reg. No. |
| Attorney | Reg. No. |
| Attorney | Reg. No. |

- a. X The power appears in the original papers in the prior application.
- b. X Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
- c. X A new power has been executed and is attached.
- d. X Address all future communications to:
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, New York 11576

(item d may only be completed by applicant, or attorney or agent of record)

15. **Maintenance of Copendency of Prior Application**

(This item must be completed and the papers filed in the **prior** application if the period set in the prior application has run.)

___ A petition, fee and response has been filed to extend the term in the pending prior application until _____.

NOTE: The PTO finds it useful if a **copy** of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the Continuation Application. Notice of November 5, 1985 (1060 O.G. 27).

___ A **copy** of the petition for extension of time in the prior application is attached.

16. Conditional Petition for Extension of Time in Prior Application

(complete this item and file conditional petition in the prior application
if previous item not applicable)

☐ a conditional petition for extension of time is being filed in the pending parent application.

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the Continuation Application. Notice of November 5, 1985 (1060 O.G. 27).

☐ A copy of the conditional petition for extension of time in the prior application is attached.

17. Abandonment of Prior Application (if applicable)

WARNING: (Do not complete this item if the application being filed is a divisional of the prior application which is not being abandoned)

NOTE: "A registered attorney or agent acting under the provisions of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138.

☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Edward R. Freedman

Type or print name of person signing

Edward R. Freedman
Signature

October 25, 2001

Date

1077 Northern Boulevard

P.O. Address of Signatory

Roslyn, New York

Tel. No.: (516) 365-9802

☐ Inventor

☐ Assignee of complete interest

☐ Person authorized to sign on behalf of assignee

Reg. No. 26,048

(if applicable)

☒ Attorney or agent of record

☐ Filed under Rule 34(a)